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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/554,276	10/25/2005	Harry Kiemele	502901-428PUS	3051
27799 7590 12/17/2010 COHEN, PONTANI, LIEBERMAN & PAVANE LLP 551 FIFTH AVENUE SUITE 1210 NEW YORK, NY 10176				
EXAMINER EVANSKO, LESLIE J				
ART UNIT 2854		PAPER NUMBER		
MAIL DATE 12/17/2010		DELIVERY MODE PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/554,276

Applicant(s)

KIEMELE ET AL.

Examiner

Leslie J. Evanisko

Art Unit

2854

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 November 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 and 19 is/are pending in the application.
- 4a) Of the above claim(s) 2,4-7,9 and 11-15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,8,10,16,17 and 19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02/09/09 & 10/25/05 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Claims 2, 4-7, 9, and 11-15 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected inventions, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on July 28, 2008.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 1, 3, 8, 10, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sakai et al. (JP 11-320989 A).

With respect to claim 1, Sakai et al. teach a printer comprising a supply of printing medium 1; a medium transport device (i.e., the drive for platen roller 3) arranged such that the printing medium can be conveyed in an output transport direction; a control unit to control the medium transport device; and where the control unit is arranged such that the control unit activates the medium transport device in such a way that the medium transport device carries out a rest state (i.e., standby time) transport at periodic intervals, even without the presence of a print job, wherein during the rest state transport, the medium transport device transports the printing medium in and/or counter to the output transport direction. Particular attention is invited to Figures 1-4, the English language abstract, and the previously attached partial English language translation of Sakai et al. Note that Sakai et al. teach the rest state transport including the transport of the printing medium in and counter to the output transport direction occurs during a waiting or standby period between prints.

Note that Sakai et al. teaches carrying out a rest state transport at periodic intervals, but fail to specifically teach the transport device carries out a rest state transport at the start of an activation of the printer caused by receipt of a print job before processing the print job. However, one of ordinary skill in the art would recognize the desirability of performing this rest state transport at any desired time between printing operations, such as at the start of activation of a printer which is about to process (i.e., print) a received print job, in order to insure there is no undesired sticking of the print medium before performing a print operation so as to insure proper

printing upon the print medium. One of ordinary skill in the art would recognize that performing this transport operation immediately prior to a printing operation would be desirable to insure the printing medium is not stuck to the thermal head or platen and can be reliably conveyed during the print operation. Therefore, it would have been obvious to one of ordinary skill in the art to provide the rest state transport of Sakai et al. to also occur at the start of activation of the printer caused by receipt of a print job to insure that there is no inadvertent sticking of the print material to the drive roller caused by long wait times between activation of the printer for various print jobs.

With respect to claim 3, Sakai et al. teach the control unit is arranged to activate the medium transport device during the rest state transport in such a way that the printing medium is initially conveyed from an initial position counter to the output transport direction (i.e., backfed to resting position) and is then transported back into the initial position in the output transport direction. See for example, the description of the embodiments of Figs. 2-4 and particularly paragraphs [0014] and [0026] which teach backfeeding the label and then feeding a label forward again such that the print start position at the time of printing of the next time at the time of returning from a waiting state does not shift. Note in particular paragraph [0014] of the partial translation indicates that an embodiment including reversing motion first and then rotating normally is also possible.

With respect to claims 8 and 19, Sakai et al. teach a method of controlling a printer comprising transporting a printing medium 1 with a medium transport device, in and opposite to an output transport direction at periodic intervals during a rest state transport. Sakai fails to teach transporting the printing medium at the start of an

activation of the printer caused by receipt of a print job before processing the print job. However, one of ordinary skill in the art would recognize the desirability of performing this rest state transport at any desired time between printing operations, such as at the start of activation of a printer which is about to process (i.e., print) a received print job, in order to insure there is no undesired sticking of the print medium before performing a print operation so as to insure proper printing upon the print medium. One of ordinary skill in the art would recognize that performing this transport operation immediately prior to a printing operation would be desirable to insure the printing medium is not stuck to the thermal head or platen and can be reliably conveyed during the print operation. Therefore, it would have been obvious to one of ordinary skill in the art to provide the transporting of the printing medium of Sakai et al. to also occur at the start of activation of the printer caused by receipt of a print job before processing the print job to insure that there is no inadvertent sticking of the print material to the drive roller caused by long wait times between activation of the printer for various print jobs.

See the previous comments with respect to claim 1. Although the printer of Sakai et al. does not specifically state that it may be used for printing out a report for a tachograph in a commercial vehicle, this language in the preamble is merely a functional recitation of an intended use and since the body of the claim fails to further limit the printer structure to that particular environment, it is the Examiner's position that the printer of Sakai et al. is capable of being used to print out a report for a tachograph as recited and thereby meets the claim language as recited. Particular attention is invited to MPEP 2111.02.

With respect to claim 10, Sakai et al. teach the method includes during the rest state transport, the printing material is initially conveyed from an initial position counter to the output transport direction and is then transported back into the initial position in the output transport direction in paragraph [0014].

5. Claims 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burkart (US 6,437,815 B1) in view of Sakai et al. (JP 11-320989).

With respect to claim 16, Burkart teaches a combination of a printer 18 integrated in a tachograph 3 for printing out a report relating to data recorded by the tachograph in a commercial vehicle, the tachograph including a higher order controller, the printer comprising a supply of printing medium 32 and a medium transport device 47 arranged such that the printing medium can be conveyed in an output transport direction, and a control unit 51, 49 arranged to control the medium transport device.

Burkart is silent with respect to the details of the control unit and whether it is arranged to activate the medium transport to carry out a rest state transport to transport the medium in and opposite to the output transport direction as particularly recited. However note that Sakai et al. teach it is well known in a printer subjected to harsh environmental conditions (such as high or low temp environments) to provide a control unit to control the medium transport device; and where the control unit is arranged such that the control unit activates the medium transport device in such a way that the medium transport device carries out a rest state (i.e., standby time) transport at periodic intervals, wherein during the rest state transport, the medium transport device transports the printing medium in and/or counter to the output transport direction.

Particular attention is invited to Figures 1-4, the English language abstract, and the previously attached partial English language translation of Sakai et al. Note that Sakai et al. teach the rest state transport including the transport of the printing medium in and counter to the output transport direction occurs during a waiting or standby period between prints.

Note that although Sakai et al. fail to specifically teach the transport device carries out a rest state transport at the start of an activation of the printer caused by receipt of a print job before processing the print job, it is the Examiner's position that one of ordinary skill in the art would recognize the desirability of performing this rest state transport at any desired time between printing operations, such as at the start of activation of a printer which is about to process (i.e., print) a received print job, in order to insure there is no undesired sticking of the print medium before performing a print operation so as to insure proper printing upon the print medium. One of ordinary skill in the art would recognize that performing this transport operation immediately prior to a printing operation would be desirable to insure the printing medium is not stuck to the thermal head or platen and can be reliably conveyed during the print operation. Therefore, it would have been obvious to one of ordinary skill in the art to provide the rest state transport of Sakai et al. to also occur at the start of activation of the printer caused by receipt of a print job to insure that there is no inadvertent sticking of the print material to the drive roller caused by long wait times between activation of the printer for various print jobs.

In view of this teaching, it would have been obvious to one of ordinary skill in the art to provide the control unit of the printer of Burkart to activate the medium transport

device to carry out a rest state transport as recited to provide more accurate printing in a tachograph in a commercial vehicle, which is subjected to harsh environmental conditions.

With respect to claim 17, Sakai et al. teach the control unit is arranged to activate the medium transport device during the rest state transport in such a way that the printing medium is initially conveyed from an initial position counter to the output transport direction (i.e., backfed to resting position) and is then transported back into the initial position in the output transport direction. See for example, the description of the embodiments of Figs. 2-4 and particularly paragraphs [0014] and [0026] which teach backfeeding the label and then feeding a label forward again such that the print start position at the time of printing of the next time at the time of returning from a waiting state does not shift. Note in particular paragraph [0014] of the partial translation indicates that an embodiment including reversing motion first and then rotating normally is also possible.

Response to Arguments

6. Applicant's arguments filed November 30, 2010 have been fully considered but they are not persuasive of any error in the above rejections.

In particular, applicant argues Sakai fails to teach performing a rest state transport upon receipt of a print job and traverses the Examiner's statement that it would have been obvious to one of ordinary skill in the art to perform the rest state transport at the start of activation of the printer to ensure the printing medium is not stuck. Specifically, applicant argues that the Examiner's statement of obviousness is not

supported by any evidence such as a citation to the prior art, or by any of the rationales for supporting a prima facie obviousness as specified in the MPEP and therefore is merely a conclusory statement based on impermissible hindsight.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Furthermore, the Examiner points out that she has provided several rationales for supporting the prima facie obviousness as set forth in the rejections above. Again, it is noted that Sakai et al. teach providing a rest state transport of the medium at period intervals for insuring the medium doesn't stick to the printhead or platen during periods when the printer is not being operated. Although Sakai et al. fail to specifically teach providing a rest state transport at the start of an activation of the printer caused by receipt of a print job, it is the Examiner's position that providing the rest state transport at any desired time between printing operations (such as immediately prior to a printing operation) would have been obvious to one of ordinary skill in the art to insure the printing medium is not stuck to the thermal head or platen and can be reliably conveyed so as to allow for proper printing.

Clearly the problem of the printing medium getting stuck to the printhead or platen of a printer during periods when the printer is not operated is a recognized problem in the prior art. Additionally, it is understood that there are a finite number of potential solutions to prevent sticking of the print medium, such as providing a cyclical movement of the printing medium, using a silicone coating on the platen and/or printhead, etc. Furthermore it is known from the prior art that the cyclical movement of the printing medium should occur during rest periods between printing operations. Thus it would have been obvious to one of ordinary skill in the art to try performing this cyclical movement (as taught by Sakai et al.) at any desired time between printing operations, such as immediately prior to a printing operation, since applying this technique would have yielded predictable results of insuring that the printing medium is not stuck to the printer structure and can be reliably conveyed.

In view of the above reasoning, the Examiner is not persuaded of any error in the above rejections.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Leslie J. Evanisko** whose telephone number is **(571) 272-2161**. The examiner can normally be reached on T-F 8:00 am-6:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Judy Nguyen can be reached on (571) 272-2258. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/ Leslie J. Evanisko /
Leslie J. Evanisko
Primary Examiner
Art Unit 2854

lje
December 15, 2010